REMARKS

Reconsideration and allowance in view of the foregoing amendment and the following remarks are respectfully requested.

Applicant affirms the election of claims 1-6 and 10-20. Claims 18 and 20 have been amended to correct the informality of the dependency from "16" to –17--. Claim 19 has been cancelled. Paragraphs [0037] and [0042] have be corrected to address the typographical errors cited by the Examiner. Claims 1-6, 10-18 and 20 remain pending in this application. Claims 1, 10, 17 and 20 have been amended.

Claims 1-6 and 10-20 have been rejected under 35 USC 112. Applicant request withdraw of the rejection based on the amendments presented herein. Concerning the Examiner's comments relating to claims 18-20, the claims depend from claim 17 as opposed to claim 10 as set forth in the Official Action. Thus, it is believed no further amendment to correct issues related to indefiniteness are warranted. The applicant request clarification if the foregoing is not accurate.

Claims 17 and 18 have been rejected by the Examiner under 35 U.S.C. 102(b) as being anticipated by Lalande, 5,721,178. Reconsideration and withdraw of the rejection is earnestly solicited.

Claim 17 recited a curable coating. The Examiner refers to a section of the claims in Lalande that disclose adhesive and silicone. While applicant disagrees that either the adhesive or silicone cited in Lalande perform the function of the coating disclosed in the present invention, applicant has amended claim 17 to include the term "frangible" prior to coating to further distinguish the invention from the prior art.

The Examiner also admits on page 11, first full paragraph that "Lalande does not disclose that the two layers have different thicknesses nor does Lalande disclose that each of said tags has a minor portion..." "A claim is anticipated if each and every element as set forth in the claim is found, either expressly or inherently described, in a single, prior art reference." Verdegaal Bros. V. Union Oil Co., of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ...claim." Richardson v. Suzuki Motor, Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Thus, based on the foregoing admission by the Examiner there can be no anticipation by Lalande of the claims as each and every element is not set forth in a single reference.

Claims 1, 2, 3, 4, 6 and 10 have been rejected by the Examiner under 35 U.S.C. 103(a) as being unpatentable over Lalande 5,721,178 and Good 5,728,440. While the Official Action refers also to "Kelly", the citation of the patent number to Good will be relied upon for this response as applicant is unaware if Kelly, which is cited in the IDS,is being relied upon. In addition, the body of the item 8 in the Official Action also includes claims 12, 13, 14 and 15 which were not set out in the preamble of the paragraph, clarification is requested. Reconsideration and withdraw of the rejection is earnestly solicited.

Neither Lalande or Good disclose or suggest the use of a frangible bond as required by the claims. Each of Lalande and Good disclose the use of adhesive and a release layer to hold items to either the carrier sheet or hang tag. As described in the application "frangible" bonds provide a temporary bond or holding arrangement. Once the bond is broken, the bond cannot be reformed unless there is remaining tacky adhesive which then may enable the assembly to be re-laminated. The use of adhesive and silicone

release agents will normally allow an adhesive coated product to once again be adhered to and removed from the release liner. This is simply not the case in the present invention, in that once the curable, frangible bond is broken; the item cannot be reattached or adhered to the carrier sheet or any other item for that matter, as there is no tack remaining in the residue once the bond has been broken. As such, there is no teaching or disclosure by Good or Lalande of the use of a frangible bond.

In connection with claims 1 and 10, the Examiner cites the passage of column 2, lines 15-28 to suggest a teaching of curing adhesive through one of the layers. However, it is clear from a reading of that selected passage that the adhesive is placed on one sheet and the second sheet is positioned over the adhesive. There is no suggestion or disclosure about applying treatment energy through one or the other of the sheets to cure the coating. In fact, applicant would suggest that since a pressure sensitive adhesive is used with a silicone coating, and the adhesive is applied in a pattern, that there no curing of the adhesive.

With respect to claim 3, Good discloses in the cited passage that the "die cut opening 15 remain attached to hang tag 10 leaving two small uncut attachments (column 3, lines 61-63)." The present invention requires that the die cut or minor portion remains with the second layer. Thus, Good teaches away from claim 3.

With respect to claims 4 and 12, the Examiner provides that "Lalande discloses the first layer 16 has a coating of silicone on the bottom surface" however, claim 12 does not require a coating of silicone. Moreover, the invention requires only a single coating which forms the bond. Lalande requires a coating of adhesive and a coating of silicone in order for the Lalande invention to work. Thus, Lalande in fact teaches away from the present invention.

In respect of claim 6, applicant disagrees with the Examiner, in that the invention requires the differential thicknesses of material in order to enable curing energy to pass through to cure the coating. Thus, the thickness is directly related to the function of the invention. As for the Examiner's comments that it would only be a matter of matter of design we offer Ex parte Markowitz, 143 USPQ 303, 304, wherein the Court held:

> "While these changes may be relatively simple once the advantage for making them has been made clear, by appellant's disclosure there is no suggestion in Ricketts et al that this should be done. Hence, the examiner's contention that Ricketts et al present a matter of choice or design in the selection of driving currents to the person of ordinary skill is true only after appellant's disclosure has shown the way."

Even if this case were properly characterized as one where there are size differences (which is not a proper characterization) there still clearly is patentable subject matter here. While size distinctions *per se* are not always unobvious, where they lead to an advantage or a different result, they can be. In this regard attention is directed to *Wagner v. Reynolds, Commissioner of Patents*, 145 USPQ 644, 646 (D.D.C. 1965). In that case, the Board of Appeals had rejected the claims over a prior art reference saying that the only difference was the difference in pore size. However, applicant's pore size had a distinct advantage compared to the prior art. The Court found this to be a clear indication of unobviousness and in the decision by Judge Jackson (retired judge of the CCPA) reversed the Board's rejection and instructed the Patent Office to issue the patent. The same situation exists here even if the distinctions are properly characterized as size distinctions.

Concerning claims 12, 13 and 14 as they depend from claim 10, the claims are patentable for the reasons set forth above.

With respect to claim 15, criticality and solving a stated problem are not criteria for patentability. What is necessary in references to defeat patentability is a suggestion or teaching for the combination of references. There must be motivation to make the combination, here there is not. As stated in Gambro Lundia AB v. Baxter Healthcare Corporation, 42 USPQ 2d 1378, 1383, 1384 (Fed. Cir. 1997):

"Thus, the obviousness question is whether the prior art would teach one of ordinary skill in this art to employ valves for recalibration during dialysis. The district court found that those skilled in the art were clearly aware of the possibility of recalibrating during dialysis, and that substituting a system of computer-controlled valves for the system of hoses in the UFM 1000 and the DM 358 was obvious to those skilled in the art at the time of the invention. However, the record must provide a teaching, suggestion or reason to substitute computer-controlled valves with a system of hoses in the prior art. The absence of such a suggestion to combine is dispositive in an obviousness determination."

It would not have been an obvious modification to change the thickness of the material, absent the suggestion provided in applicant's invention. The thickness differential permits curing energy to pass to the coating in order to create a frangible bond.

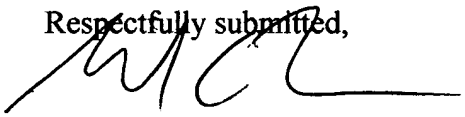
Claims 5, 11, 16, 19 and 20 have been rejected by the Examiner under 35 U.S.C. 102(b) as being unpatentable over Lalande 5,721,178 in view of Good 5,728,440 and further in view of Tighe 4,704,310. Reconsideration and withdraw of the rejection is earnestly solicited. Claim 19 has been cancelled.

The combination does not render the invention unpatentable. Tighe discloses the use of UV curing energy to create a barrier layer after being coated onto a release layer. The purpose of the barrier layer is to "thus prevents release layer 20 from sticking to the carrier web 10 (column 7, lines 20-21). The purpose of the coating in the instant

invention is to cause the layers to be bonded together, not to prevent layers from sticking to each other and as such, Tighe teaches away from the invention as the creation of a barrier layer to prevent sticking in either Lalande or Good would likely cause the element to fall away from the carrier layer.

All objections and rejections having been addressed, it is respectfully submitted that the present application is in condition for allowance and an early Notice to that effect is earnestly solicited.

Respectfully submitted,



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